



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/049,887	09/20/2002	Yasunori Chiba	081356-0168	2894

22428 7590 12/16/2004

FOLEY AND LARDNER  
SUITE 500  
3000 K STREET NW  
WASHINGTON, DC 20007

EXAMINER

PAK, YONG D

ART UNIT PAPER NUMBER

1652

DATE MAILED: 12/16/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/049,887	CHIBA ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Yong D Pak	1652	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
  - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
  - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
  - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 12 October 2004.
- 2a) ☐ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 39-87 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 39-87 are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                        | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date. _____  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____   | 6) <input type="checkbox"/> Other: _____                                    |

### **DETAILED ACTION**

This application is a 371 of PCT/BG00/04720.

The preliminary amendment filed on October 12, 2004, canceling claims 1-38 and adding claims 39-87, has been entered.

Claims 39-87 are pending and are subject to restriction.

Examiner notes that claim 85 has been interpreted as depending from claim 70 instead of claim 707 because claim 707 does not exist.

### ***Election/Restrictions***

Restriction is required under 35 U.S.C. 121 and 372.

This application contains the following inventions or groups of inventions which are not so linked as to form a single general inventive concept under PCT Rule 13.1.

In accordance with 37 CFR 1.499, applicant is required, in reply to this action, to elect a single invention to which the claims must be restricted.

Group I, claim(s) 39, 41, 43, 61-62 and 64, drawn to a method of preparing a mutant yeast comprising GnT-I gene.

Group II, claim(s) 40, 42, 63 and 65, drawn to a method of preparing a mutant yeast comprising GnT-I gene, mannosidase II gene and a GnT-II gene.

Group III, claim(s) 44, 46, 48-50, 67, 70, 73, 85 and 87, drawn to a method of preparing a mutant yeast comprising GnT-I gene and a mannosidase I gene.

Group IV, claim(s) 45, 47, 66, 68, 69, 71, 72, 74, 84 and 86, drawn to a method of preparing a mutant yeast expressing GnT-I protein, GnT-II protein, mannosidase I protein and a mannosidase II protein.

Group V, claim(s) 51, 53, 55-57, 76, 79 and 82, drawn to a method of preparing a mutant yeast expressing a mannosidase I protein.

Art Unit: 1652

Group VI, claim(s) 52, 54, 75, 77, 78, 80, 81 and 83, drawn to a method of preparing a mutant yeast expressing mannosidase I protein, a GnT-I protein and a GnT-II protein.

Group VII, claim(s) 58-60, drawn to a method of preparing a mutant yeast by disrupting a regenerable auxotrophic marker.

The inventions listed as Groups I-VII do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical features for the following reasons:

The method of Groups I-VII are not linked by any special technical features. The methods of Groups I-VII are drawn to preparing mutant yeasts having different proteins. The methods utilize different materials, different steps and have different effects.

The special technical feature of Group I is a method of preparing a mutant yeast comprising GnT-I gene.

The special technical feature of Group II is a method of preparing a mutant yeast comprising GnT-I gene, mannosidase II gene and a GnT-II gene.

The special technical feature of Group III is a method of preparing a mutant yeast comprising GnT-I gene and a mannosidase I gene.

The special technical feature of Group IV is a method of preparing a mutant yeast expressing GnT-I protein, GnT-II protein, mannosidase I protein and a mannosidase II protein.

The special technical feature of Group V is a method of preparing a mutant yeast expressing a mannosidase I protein.

The special technical feature of Group VI is a method of preparing a mutant yeast expressing mannosidase I protein, a GnT-I protein and a GnT-II protein.

The special technical feature of Group VII is a method of preparing a mutant yeast by disrupting a regenerable auxotrophic marker

Accordingly, Groups I-VII are not so linked by the same or a corresponding special technical feature as to form a single general inventive concept.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

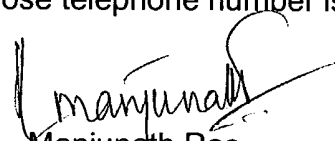
Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Yong Pak whose telephone number is 571-272-0935. The examiner can normally be reached 6:30 A.M. to 5:00 P.M. Monday through Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ponnathapu Achutamurthy can be reached on 571-272-0928. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9306 for regular communications and 703-872-9307 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 571-272-1600.

Yong D. Pak  
Patent Examiner 1652

  
Manjunath Rao  
Primary Examiner 1652  
Art Unit 1652